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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,005	06/21/2001	Kazuo Kuroda	1767-83	3546

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
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2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/885,005

Applicant(s)

KURODA ET AL.

Examiner

HELEN SHIBRU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-14,16-21,23,25-30,33 and 35-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-14,16-21,23,25-30,33 and 35-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/2006 has been entered.

Response to Amendment

2. The amendments filed on 12/19/2006 have been entered and made of record. Claims 2, 4-5, 15, 22, 24, 31-32, 34 are cancelled and claims 1, 3, 6-14, 16-21, 23, 25-30, 33, 35-48 are pending.

Response to Arguments

3. Applicant's arguments filed 12/19/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the cited reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., having two recording mediums or data is outputted from a first recording medium (Applicant's attention is directed to page 21 paragraph 1 of the remarks)) are not recited in the rejected claim(s). An outputting device can be any device that outputs recording position of partial information. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner also would like to point out that buffer is a recording medium though it records data temporarily. Claim 1 does not specifically recites if the recording medium is a temporary or permanent data storage medium.

See the new grounds of rejections sets forth below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 6-14, 16-20, 30, and 33-45 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Utsumi (US Pat. No. 6,400,667).

Regarding claim 1, Utsumi discloses an information inputting apparatus comprising an outputting device for outputting main information including a plurality of partial information and recording position information showing a recording position of the partial information on a recording medium on which the partial information is to be recorded (see col. 3 line 54-col. 4 line 2, claims 13 and 19 where it shows the main management data and sub management data, which include the recording position information of the main data and the sub data, are writing onto the recording medium. See col. 33 lines 14-25, line 56-col. 34 line 6),

wherein the outputting device cyclically outputs the whole of the main information, wherein in each session of outputting the whole of the main information, the outputting device sequentially outputs the partial information and the recording position in accordance with an

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order of recording or reproducing, (see col. 16 lines 54-64, col. 13 lines 19-38, col. 14 line 33-col. 15 line 2, and col. 16 lines 49-64 and col. 30 lines 13-20, and figures 23A-E), and wherein the recording position information has a predetermined relationship with address information set in advance in the recording medium (see col. 31 lines 18-27, col. 42 lines 42-50).

Regarding claim 3, Utsumi discloses the main information is compressed by a variable bit rate (see col. 34 lines 43-61).

Claim 12 is rejected for the same reason as discussed in claim 1 above.

Regarding claim 6, Utsumi discloses the main information includes reproduction controlling information for controlling a reproduction manner of the main information recorded in the recording medium, and the outputting device sequentially outputs the reproduction controlling information, the partial information, and the recording position (see col. 3 line 54-col. 4 line 2. See also col. 9 lines 36-58. col. 13 lines 19-38, col. 14 line 33-col. 15 line 2, and col. 16 lines 49-64 and col. 30 lines 13-20, col. 45 lines 24-30, and figures 23A-E).

Regarding claim 7, Utsumi discloses the main information includes regulating information for regulating the number of times for copying after the main information is recoded in the recording medium (see col. 20 line 64-col. 21 line 15), and

the information outputting apparatus further comprises a changing device for generating changing recording position information by changing each of the recording position information in association with the regulating information (see col. 21 lines 26-38 and see claim 1 rejection and paragraph 3 above), and

the outputting device sequentially outputs at least the partial information and the changing recording position information, which is added to the partial information and is

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generated by the changing device, in accordance with the changing order information (see claim 1 rejection and paragraph 3 above, and col. 20 lines 1-17).

Regarding claim 8, Utsumi discloses the partial information comprises an information sector (see col. 11 lines 24-32), and the recording position information is any one of sector address information in association with respective information sectors and relative information which is related to the sector address information (see col. 11 line 66-col. 12 line 6 and col. 15 lines 3-7).

Regarding claim 9, Utsumi discloses an information recording apparatus for recording main information which is outputted from an information outputting apparatus, in a recording medium (see col. 9 lines 53-58 and col. 33 lines 21-25 and 34-40) wherein the information outputting apparatus comprises: an outputting device for outputting the main information including a plurality partial information (see col. 33 lines 21-25) and recording position information showing a recording position of the partial information on a recording medium on which the partial information is to be recorded, wherein the outputting device cyclically outputs the whole of the main information, and in each session of outputting the whole of the main information, the outputting device sequentially outputs the partial information and the recording position information in accordance with an order of recording or reproducing (see col. 33 lines 14-20 and line 56-col.34 line 6, col. 39 lines 27-43 and col. 44 lines 30-40, controller (11) in fig. 1, and claim 1 rejection and paragraph 3 above),

wherein the information recording apparatus comprises:

an obtaining device for obtaining the outputted partial information and recording position information in the main information (see col. 42 line 63-col. 43 line 5, see also claim 1 rejection); and

a recording device for recording the obtained partial information in the recording medium by using the recording position information (see col. 8 line 29-47),

wherein the recording device determines whether the whole of one main information is completely recorded or not in accordance with the recorded recording position information (see col. 19 and 20, and claim 1 rejection and paragraph 3 above), and

when the recording device determines that the whole of the one main information is not completely recorded in session, the recording device records remaining partial information and recording position information in the one main information in another session (see paragraph 3 above),

wherein the recording position information has a predetermined relationship with address information set in advance in the recording medium (see col. 31 lines 18-27, col. 42 lines 42-50).

Claims 11, 17, and 20 are rejected for the same reason as described in claim 8 above.

Regarding claim 13, the limitation of claim 13 can be found in claim 1. Therefore claim 13 is analyzed and rejected for the same reason as discussed in claim 1 above.

Claim 14 is rejected for the same reason as discussed in claim 3 above.

Claim 16 is rejected for the same reason as discussed in claim 7 above.

Claim 18 is rejected for the same reason as discussed in claim 9 above.

Claim 19 is rejected for the same reason as discussed in claim 10 above.

Claim 30 is rejected for the same reason as discussed in claim 9 above.

Regarding claim 33, Utsumi discloses an output apparatus for outputting contents that are distributed to a recording apparatus, the output apparatus comprising:

an outputting section for repeatedly outputting an entire information unit comprising a plurality of information pieces, each information piece being output with associated recording position information indicative of that information piece's recording position on a recording medium on which the information pieces are to be recorded (see figures 1, 29-31), and

a transmitting section for transmitting the information pieces and associated recording position information to a recording apparatus for recording the information pieces onto the recording medium in accordance with the recording position information (see figure 30 and rejection of claim 1 and paragraph 3 above),

wherein the recording position information has a predetermined relationship with address information set in advance in the recording medium (see col. 31 lines 18-27, col. 42 lines 42-50).

Regarding claim 35, Utsumi discloses the information pieces are copy-controlled (see figures 19A and B).

Regarding claim 36, Utsumi discloses a receiving section for receiving information pieces of an entire information unit repeatedly transmitted by the output apparatus, each information piece having associated recording position information indicative of that information piece's recording position on a recording medium on which the information pieces are to be recorded (see col. 28-29 and figures 30-31), and

a recording section for recording the received information pieces onto the recording medium, wherein the recording section uses the recording position information so that recording of the information pieces onto the recording medium can begin even if an information piece

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initially received by the receiving section is not the first information piece in a recording reproducing order and so that recording of the information pieces onto the recording medium can be completed during a subsequent one of the repeated transmissions of the entire information unit by the output apparatus (see col. 30-32 and figures 19b, 29-31),

wherein the recording position information has a predetermined relationship with address information set in advance in the recording medium (see col. 31 lines 18-27, col. 42 lines 42-50).

Regarding claim 37, Utsumi discloses the recording section records the information pieces onto the recording medium so that the first information piece in the recording reproducing order is recorded at the beginning of a data area of the recording medium (see col. 22 lines 36-45).

Regarding claim 38, Utsumi discloses the recording section records the information pieces onto the recording medium so that the first information received by the receiving section is recorded at the beginning of a data area of the recording medium (see col. 22 lines 36-45).

Regarding claim 39, Utsumi discloses the recording position information for each information piece comprises sector address information specifying a sector on the recording medium at which that information piece is to be recorded (see figs. 5-18).

Regarding claim 40, Utsumi discloses the receiving section is configured to receive information pieces communicated over a wide area network (see col. 21 lines 30-38, col. 22 lines 1-4, col. 25 lines 50-56).

Regarding claim 41, Utsumi discloses the recording section is configured to record the received information pieces onto an optical disk (see figs 1 and 2A-B).

Regarding claims 42-45, and 48, Utsumi discloses each of the recording position information is added to each of the partial information (see figs. 23A-E and col. 3 line 54-col. 4 line 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21, 23, 25-29, 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi.

Regarding claim 21, the limitations in this claim can be found in the apparatus claim 1. However claim 21 further requires a recording medium for storing a program causing the computer to execute steps as claimed in claim 1. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Kawamura by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Claim 23 is rejected for the same reason as discussed in claim 3 above.

Claim 25 is rejected for the same reason as discussed in claim 7 above.

Claim 26 is rejected for the same reason as discussed in claim 10 above.

Regarding claim 27, the limitations in this claim can be found in the apparatus claim 9. However claim 27 further requires a recording medium for storing a program causing the computer to execute steps as claimed in claim 9. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Kawamura by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Claim 28 is rejected for the same reason as discussed in claim 10 above.

Claim 29 is rejected for the same reason as discussed in claim 8 above.

Claims 46-47 are rejected for the same reason as discussed in claim 42 above.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 21, 23, 25-29, 46, and 47 are rejected under 35 U.S.C. 101 because data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. In addition a mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes

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performed by the computer then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer, and therefore are not statutory. See MPEP 2106.IV.B.1.

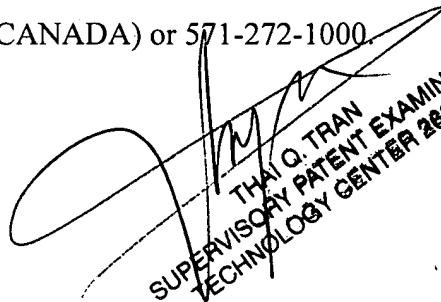
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru


THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800